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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,963	07/25/2001	Yoshi Fujita	393032027300	7127

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MORRISON & FOERSTER, LLP
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EXAMINER

SELLERS, DANIEL R

ART UNIT	PAPER NUMBER
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2615

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/912,963	Applicant(s) FUJITA ET AL.	
	Examiner Daniel R. Sellers	Art Unit 2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,9,14 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,9,14, and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed January 17, 2007 have been fully considered but they are not persuasive.
2. The rejection under 35 U.S.C. 102(b) with respect to the amended claims 1, 9, 14, and 19 is maintained, because there is no recitation that the limiting functions automatically happen during operation of recording and/or reproducing signals.
3. Applicant's arguments, see p. 14, filed January 17, 2007, with respect to claims 20-22 have been fully considered and are persuasive. The rejection of claims 20-22 has been withdrawn, however a rejection under 35 USC 101 follows.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. **Claims 1, 9, 14, and 19-22** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
6. **Claim 1** is seemingly a patentable apparatus, however, it is in reality seeking patent protection of the computer program as evidenced by claim 14. It is non-statutory because it lacks a practical application by physical transformation. There is no positive recitation of a practical application of limiting a number of tracks, muting a number of tracks, and designating other tracks for recording (i.e. Claim 1 is seeking protection for settings of an apparatus without claiming an outcome of these settings). Furthermore, it is non-statutory because it lacks a practical application that produces a useful, concrete,

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and tangible result. A practical application, which provides a useful, concrete, and tangible result, is needed.

7. **Claim 9** is non-statutory for the same reasons as claim 1.

8. **Claim 14** is non-statutory because the claimed invention does not fall under a statutory category or judicial exception. The claim is seeking patent protection for a computer "program embodied on a computer readable medium". Acceptable language for claiming a computer program would be "a computer readable medium embodied with a computer program" or "a computer readable medium embodied with computer executable instructions". When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized (MPEP 2106.01).

9. **Claim 19** is non-statutory because it depends on claim 1.

10. **Claim 20** is non-statutory for similar reasons as claim 1. Claim 20 recites a display section, several outputs of audio data, and several sections that cause display of a status. However, no positive recitation of displaying a change in status, a transmission of an output to record a signal, or a transmission of an output to be heard by the user of the system is claimed. A practical application by physical transformation is required (i.e. a positive display step or a positive transmittal of data to be recorded or heard is needed), and the practical application needs to produce a useful, concrete, and tangible result.

11. **Claims 21 and 22** are non-statutory for the same reason as claim 20.

Claim Rejections - 35 USC § 102

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. **Claims 1, 9, 14, and 19** are rejected under 35 U.S.C. 102(b) as being clearly anticipated by the Owner's Manual of the VS-1680 Digital Studio Workstation by the Roland Corporation (hereinafter Roland).

14. Regarding amended **claim 1**, Roland teaches a digital multi-track recording/reproducing device that allows for designating the recording/reproducing status of each track and teaches a track-setting section to designate a plurality of tracks to selectively record (p. 36, Switching Track Conditions). Roland also teaches a mute ON and mute OFF state, wherein a plurality of tracks can be selected for playback and another plurality of tracks can be selected for recording, and it is inherent that some tracks may be omitted in either selection (p. 68, Recording to Other Tracks). They teach that you cannot specify more than eight (8) tracks for record or source, wherein source is taught to be a monitoring track. It is inherent, in the art of recording and reproducing audio on a digital audio workstation, that the number of tracks to be recorded to or played back is limited by the hardware used to implement the system. Roland teaches that this limit causes a choice of allowing the user to select a channel and override a previous setting of another channel, or to disallow the user to select a channel, which would override a previous designation to any or all channels and this thereby reads on the reproducing track number-limiting section (p. 24, bus descriptions). Roland further teaches in the appendices (incorporated by reference in the Owner's

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Manual, p. 12) that a mute on and off function is automatically performed when bouncing tracks (Appendices, p. 10, "All of the tracks...."). Roland teaches that a reproducible number (16) is limited in this case and if this number is exceeded then a track is automatically muted.

15. Regarding amended **claim 9**, see the preceding argument with respect to claim

1. Roland teaches this method.

16. Regarding amended **claim 14**, see the preceding argument with respect to claim

1. Roland teaches this feature, and it is inherent, in Roland's digital audio workstation, that a program is being executed to perform this functionality.

17. Regarding amended **claim 19**, the further limitation of claim 1, Roland teaches a mode designating section with these features (p. 24). It is inherent that a bit number, or track number, is used to designate which tracks are selected for the recording bus or the mix bus, wherein the mix bus comprises the tracks for playback.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ajamian, U.S. Patent No. 6,870,936.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel R. Sellers whose telephone number is 571-272-7528. The examiner can normally be reached on Monday to Friday, 9am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571)272-7564. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SINH TRAN
SUPERVISORY PATENT EXAMINER

DRS